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| 10/650,555 | 08/28/2003 | Michael Wayne Brown | AUS920010818US2 | 7605 |
| 34533 7590 05/01/2008 INTERNATIONAL CORP (BLF) c/o BIGGERS & OHANIAN, LLP P.O. BOX 1469 AUSTIN, TX 78767-1469 | | | | |
| EXAMINER | | | | |
| ELAHEE, MD S | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/650,555

Applicant(s)

BROWN ET AL.

Examiner

MD S. ELAHEE

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-9,11-13,15-30 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9,11-13,15-30 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed on 02/14/2008. Claims 1, 2, 4-9, 11-13, 15-30 and 36 are pending. Claims 10 and 33-35 have been previously cancelled. Claims 3, 14, 26, 31 and 32 have been currently cancelled.

Response to Arguments

2. Applicant's arguments filed in the 02/14/2008 Remarks have been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the needs at this time.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 2, 4-9, 11-13, 15-23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 12, the phrase "said caller identity is transmittable" is indefinite because it is unclear whether said caller identity is transmitted to the destination or said caller identity is not transmitted to the destination.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 24, 25 and 27-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Independent claim 24 recites, in pertinent part, a computer program product comprising a recording medium with means recorded on the medium to perform the recited functions. The Specification indicates that "computer readable media include recordable-type media, such as a floppy disk, a hard disk drive, a RAM, CD-ROMs, DVD-ROMs, and *transmission-type media, such as digital and analog communication links', wired or wireless communications links' using transmission forms, such as, for example, radio frequency and light wave transmissions*" (see page 29, lines 25-28 of the original Spec.; emphasis added). Thus, reading independent claim 24 in light of the Specification, the recited "computer readable medium" of these claims encompasses a carrier medium that conveys a signal.

Signals are not patentable subject matter under § 101.

In any event, *a carrier medium that conveys* a signal (e.g., a carrier wave) is distinguished from a tangible medium that *stores* a signal (e.g., a disk, memory, etc.), particularly with respect to the functionality of independent claim 24. This claim, in effect, call for means to interact with the computer to perform specific functions. It is our view that the computer cannot perform the claimed functions while the instructions are within signals conveyed by a carrier wave.

Specifically, information sent by a carrier wave conveying signals is transmitted by modulating the carrier wave or signal with the information. This information must be received and demodulated before the information is available for use. Thus, the information, *while on the carrier wave or signal*, is unavailable to the computer for performing the functions recited in independent claim 24. It is also likely that all the information necessary to perform the functions of claim 24 never exists within the carrier wave or signal at any one time. In other words, it is typical for information that is transmitted by signals conveyed by carrier waves to begin to be received at the receiver before all the information is transmitted. Therefore, it appears that program instructions for carrying out the claimed invention cannot exist while the information is being transmitted via signals conveyed by a carrier wave.

Furthermore, while the exemplary "transmission-type media" disclosed on page 29 of the Specification certainly implicates physical carriers of information, the disclosure hardly limits the carriers to these examples. Rather, nothing in the passage precludes the use of any tangible means of information carriage.

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Thus, when read in light of the Specification, independent claim 24 includes both statutory subject matter (signals stored on a tangible medium) and non-statutory subject matter (signals conveyed by a carrier medium). According to USPTO guidelines, however, such claims must be amended to recite solely statutory subject matter.

For the foregoing reasons, independent claim 24 or the claims dependent thereon do not recite statutory subject matter under 35 U.S.C 101.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(c), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1, 2, 4-7, 11-13, 15-18, 21, 23-25, 27-30 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farris et al. (U.S. Patent No. 6,122,357) in view of Velius (U.S. Patent No. 5,594,784) further in view of Manto (U.S. Patent No. 6,285,749).

Regarding claims 1, 12, 21, with respect to Figures 1, 4, 5, Farris teaches a method for identifying a particular caller, said method comprising:

detecting a voice utterance at IP23 [i.e., an origin device], the origin device further comprising a telephony device (fig.1; col.11, lines 32-41, col.19, lines 32-46, col.35, lines 18-27);

identifying a caller identity associated with said voice utterance at said origin device, such that said caller identity is transmittable as an authenticated identity of said caller for a call (col.19, lines 65-67, col.20, lines 1-5, col.35, lines 18-27).

However, Farris does not teach the IP23 originating the call. The call of Farris is originated from the telephone terminal of the caller.

Again, Farris teaches that a voice identification recognizer/software is located in the IP23 to perform the claimed identification feature (fig.1).

Also, Velius teaches that the caller's terminal (customer premise equipment in Fig.1B) is equipped with the speech recognition software (26, Fig.1B) for identifying utterances of a caller (see col.5, line 65-col.6, line 5, col.7, lines 19-21). Velius further teaches that the caller's terminal is equipped with a memory dialing list (col.6, lines 23-25). The list stores relevant speech patterns such that the patterns are used for comparing the speech input of a caller (col.6, lines 23-29). This comparison is used to recognize the voice utterances of the caller (col.7, lines 21-25).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the caller's telephone terminal of Farris to incorporate the voice recognizer/software and the identification database. The caller's terminal can then originate outgoing call and identify the calling party as claimed. Farris clearly teaches such modification by moving the software from the IP23 to the caller's terminal. Velius's invention proves that similar voice recognition software had been placed in the caller's terminal. The modification enables the caller's terminal to identify the identity of the calling party. Furthermore, the modification of moving the recognition software to the caller's terminal gives additional benefit of reducing the traffic between the caller's terminal and the IP23.

Farris teaches prompting said caller to make additional attempts [i.e., enter an additional input] to verify said caller identity (col.35, lines 41-45).

However, Farris in view of Velius does not teach that the input is a biometric input comprising at least one among an eye print, a finger print, and a body heat scan. Manto teaches that the input is a biometric input comprising at least one among an eye print, a finger print, and a body heat scan (col.5, lines 1-19). Thus, it would have been obvious to one of ordinary skill in

the art at the time the invention was made to modify the caller's telephone terminal of Farris in view of Velius to incorporate the feature of a biometric input comprising at least one among an eye print, a finger print, and a body heat scan. The modification enables the caller's terminal to identify the identity of the calling party based on finger print.

Regarding claims 2, 13, 25, Farris teaches prompting said caller to provide said voice utterance (col.19, lines 32-46, col.35, lines 18-27).

Regarding claims 4, 15, 27, Farris teaches wherein identifying a caller identity further comprises:

extracting speech characteristics from said voice utterance (col.19, lines 65, 66); and
comparing said speech characteristics with a plurality of voice samples stored for identifying a plurality of callers (col.19, lines 66,67,col.20, lines 1-5).

Regarding claims 5, 16, 28, Farris teaches the method for identifying a particular caller according to claim 1, further comprising:

transmitting said voice utterance to a IP23 [i.e., third party device] via a network (fig.1; col.19, line 65, col.35, lines 21-26) ; and

receiving said caller identity from said third party device (col.20, lines 1-5, col.35, lines 26,27).

Regarding claims 6, 17, 29, Farris teaches the method for identifying a particular caller according to claim 1, further comprising:

requesting a voice sample for said particular caller from a IP23_R [i.e., third party device] accessible via a network (fig.1; col.19, lines 60-63, 65, col.35, lines 21-26); and

receiving said voice sample for said particular caller for enabling authenticating of said caller identity (col.20, lines 1-5, col.35, lines 26,27).

Regarding claims 7, 18, 30, Farris teaches the method for identifying a particular caller according to claim 1, further comprising:

initiating a call from said origin device to a central office 11_I (fig.1) [i.e., intermediary device] (col.20, lines 55-57); and

forwarding said caller identity with said call initiation to said intermediary device, wherein said intermediary device is enabled to forward said caller identity to a destination station 1_B (fig.1) [i.e., destination device] to process said call (col.20, lines 57-63).

Regarding claim 11, Farris teaches the method for identifying a particular caller according to claim 1, wherein said caller identity comprises at least one from among a caller name, a caller location, a subject of said call, and a device identification (col.19, line 40, col.35, lines 23, 24).

Claim 24 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Farris teaches a program store [i.e., recording medium] (fig.2; col.15, lines 40-47).

Claim 36 is rejected for the same reasons as discussed above with respect to claims 1, 5 and 6.

11. Claims 8, 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farris et al. in view of Velius further in view of Manto further in view of Chan (U.S. Patent No. 6,925,166).

Regarding claims 8 and 19, Farris in view of Velius further in view of Manto does not specifically teach "said origin device is a call center". Chan teaches that the origin device is a call center (fig.2, step 100; col.3, lines 53-57, 66, 67). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Farris in view of Velius further in view of Manto to incorporate the origin device being a call center as taught by Chan. The motivation for the modification is to do so in order to provide outbound call from a call center to a target party.

Regarding claim 22, Farris in view of Velius further in view of Manto does not specifically teach "said origin device is a computer system communicatively connected to a network enabled for voice communications". Chan teaches that the origin device is a computer system communicatively connected to a network enabled for voice communications (fig.2, step 100; col.3, lines 53-57, 66, 67). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Farris in view of Velius further in view of Manto to incorporate the origin device being a computer system communicatively connected to a

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network enabled for voice communications as taught by Chan. The motivation for the modification is to do so in order to provide outbound call from a computer system to a destination such that a computer terminal can function as calling device.

12. Claims 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farris et al. in view of Velius further in view of Manto further in view of Baker (U.S. Patent No. 5,533,109).

Regarding claims 9 and 20, Farris in view of Velius further in view of Manto fails to teach “said origin device is a private exchange network”. Baker teaches that the calling party device [i.e., origin device] is a PBX unit [i.e., private exchange network] (fig.1, fig.2; col.2, lines 26-55). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Farris in view of Velius further in view of Manto to incorporate the origin device being a private exchange network as taught by Baker. The motivation for the modification is to have the private exchange network in order to provide the multiple users as the calling party.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MD S. ELAHEE whose telephone number is (571)272-7536. The examiner can normally be reached on Mon to Fri from 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fan Tsang/

Supervisory Patent Examiner, Art Unit 2614

/M. E./

MD SHAFIUL ALAM ELAHEE

Examiner

Art Unit 2614

May 1, 2008